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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/867,907	05/30/2001	David Blight	035451-0122 (3605.Palm)	7557

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EXAMINER

SHARMA, SUJATHA R

ART UNIT PAPER NUMBER

2684

DATE MAILED: 04/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/867,907

Applicant(s)

BLIGHT, DAVID

Examiner

Sujatha Sharma

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-24 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

AFFIDAVIT AND DECLARATION

1. The declaration filed on 11/12/04 under 37 CFR 1.131 has been considered but is ineffective to overcome the Parry reference due to missing signature.
2. However, upon approval of the petition under 37 CFR 1.47(a), it is suggested that the applicant resubmit the declaration under 37 CFR 1.131.

Response to Amendment

3. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Parry reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).
4. The office has not received the following papers, as indicated by the applicant in the unsigned declaration, as evidence of conception before the effective date of the Parry reference.
 - a) A copy of an electronic mail message dated February 22, 2001 from Senior Patent Attorney Henry Ohab of Palm, Inc. to Alistair Chan of Foley & Lardner LLP. The message had attached an Invention Disclosure Form and a document describing the subject matter of the '907 application.
 - b) A copy of the Invention Disclosure Form referred to in a), indicating a date of conception of January 30, 2001 on page 2, section 3.

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c) A copy of the document referred to in a) describing the subject matter of the &907 application.

Therefore in view of the above arguments, the prior art still applies and the rejection discussed in the previous office action mailed 5/27/04 and as discussed below is considered proper.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 6,11,17 recites the limitation "the estimated position" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Further claim, 6,11,17 are directed to sending a reply to the location service indicating an incorrect estimated position. However it is unclear how this determination is performed. In order to determine that the estimated position is incorrect, there is a need for a comparative element and the claims do not provide for this comparative element.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 1-5,7-10,12-16,18-24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Parry [2002/0164997] in view of Aarnio [US 20030087650].

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Regarding claims 1,7,12,18,24, Parry discloses a method of determining location of a mobile device comprising:

- gathering a list of addresses of nearby devices in communication with a network; see pages 3-4, paragraph 34
- accessing a database of known device; see pages 3-4, paragraph 34
- correlating the list of addresses with zone information of the database; see pages 3-4, paragraphs 34 and 37

However Parry does not disclose a method of sending a location request to location service accessible through the network accessed wirelessly by the mobile device.

Aarnio, in the same field of endeavor, teaches a method of sending a location request to location service accessible through the network accessed wirelessly by the mobile device. See page 2, paragraph 18.

Therefore it would have been obvious to one with ordinary skill in the art to provide the above teaching of Aarnio to Parry in order to provide the user with location dependent services.

Regarding claim 2, Parry further discloses a method of receiving from the location service an estimated position of the mobile device. See page 4, paragraph 37.

Regarding claims 3,8,13, Aarnio further discloses a method wherein the location information includes a text-based description. See page 2, paragraph 18.

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Regarding claims 4,9,15, Parry discloses a method of providing an approximate position of the mobile device to the location service. See page 3, paragraph 34 and page 4, paragraph 37.

Regarding claims 5,10,16, Parry further discloses a method wherein the approximate position is determined by a global positioning system (GPS) device.

Regarding claim 14, Parry further discloses a method wherein the location estimation includes a graphical description of the mobile device location. See pages 3-4, paragraph 34.

Regarding claim 19, Parry further discloses the wireless device to include a bluetooth transceiver. See page 3, paragraph 28.

Regarding claim 20, Parry further discloses the wireless device to include an IEEE 802.11 transceiver. See page 3, paragraph 28.

Regarding claim 21, Parry discloses a method wherein the at least one other device includes a printer. See page 2, paragraph 26.

Regarding claim 22, Parry discloses a method wherein the at least one other device includes a computer. See page 2, paragraph 27.

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Regarding claim 23, Parry discloses a method wherein the estimated position of the wireless device is provided on a graphical map. See Figs. 6,8 and page 4, paragraph 38.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sujatha Sharma whose telephone number is ~~703-305-5298~~ ⁵⁷¹⁻²⁷²⁻⁷⁸⁸⁶. The examiner can normally be reached on Mon-Fri 7.30am - 4.00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nay Maung can be reached on ~~703-308-7745~~ ⁵⁷¹⁻²⁷²⁻⁷⁸⁸². The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Sujatha Sharma
April 5, 2005


NAY MAUNG
SUPERVISORY PATENT EXAMINER